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| 10/821,041      | 04/08/2004  | Colin T. Metcalfe    | 50180               | 9253             |

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SUE Z. SHAPER, P.C.  
1800 WEST LOOP SOUTH  
SUITE 1450  
HOUSTON, TX 77027

EXAMINER

ARK, DARREN W

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3643

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/821,041

Applicant(s)

METCALFE, COLIN T.

Examiner

Darren W. Ark

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 15, 16 and 21-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 15, 16 and 21-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Inventorship*

1. The Examiner would like to indicate that there are issues with the inventorship in this application since the inventors of U.S. Pat. Application 09/736,023 of Howse et al. have not signed and executed the Oath filed 5/17/2004 and that Mr. Colin T. Metcalfe represents an entirely new inventor who was not an inventor on U.S. Pat. Application 09/736,023. Therefore this application cannot be considered to be a properly executed Continuation of U.S. Pat. Application No. 09/736,023.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-7, 15, 16, 21-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16, 18-44, 46-48, and 50 of copending Application No. 09/736,023. Although the conflicting claims are not identical, they are not patentably distinct from each other because a

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method of trapping insects comprising using a particulate composition vs. particles comprising at least one magnetic material in an electromagnetically sensitive material which includes strontium ferrite vs. a magnetic material; a cockroach affecting composition/pesticidal composition in particulate form which includes electromagnetically sensitive particles with a magnetic material which includes strontium ferrite vs. a core being impregnated or coated with a magnetic material; an insect trap having a composition comprising a magnetic material in the electromagnetically sensitive particles which includes strontium ferrite vs. a composition including particles comprising a magnetic material of opposite polarity to that of the magnetically polarized material.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Objections***

4. Claims 3, 3/5, 3/5/6, 5, 5/6, 22, 25, 26 are objected to because of the following informalities:

Claim 3, line 1, "claims" should be changed to "claim".

Claim 5, line 1, "claims" should be changed to "claim".

Claim 22, line 1, "claims" should be changed to "claim".

Claim 25, line 1, "claims" should be changed to "claim".

Claim 26, line 1, "claims" should be changed to "claim".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claims 1-7, these claims do not set forth any positive method steps to perform "A method of trapping and/or killing pests" and therefore it is unclear as to what method applicant is intending to encompass. A method claim is indefinite if it merely recites a use without any active, positive steps delimiting how this use is actually practiced. In order to "trap" insects the use of some sort of trap structure (ie. housing) must be recited (such as "providing a housing...").

In regard to claim 4, the phrase "adhere by a magnetic force to a surface which is inclined to horizontal" renders the claim vague and indefinite since the surface is not being clearly recited as part of the trap and could be interpreted as any inclined surface on which the particles are deposited.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 15, 16, 22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Marston 3,056,724.

In regard to claim 15, Marston discloses a pesticidal composition (pellet for ruminants) in particulate form which includes electromagnetically sensitive particles having a behaviour modifying effect (low density biologically active substance the particles of which are moulded or compressed around the core; see col. 7, lines 56-end & col. 8, lines 1-47, esp. lines 38-41; particles may also affect behavior by presenting an obstacle around which the insect must walk around) upon contact with a cockroach foot, an improvement comprising including in the particles a magnetic material (cobalt oxide mixed with iron powder; also metal core which for example could be an iron bar or steel ball or roller bearing; also see col. 4, lines 31-36 & col. 8, lines 54-59).

In regard to claim 50, Marston discloses a plurality of particles (pellets) of a magnetic material (cobalt oxide with iron powder) having only on an external coating comprising a pesticide or behaviour modifying chemical (low density biologically active substance).

9. Claims 15, 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gref et al. 5,565,215.

In regard to claim 15, Gref et al. discloses a pesticidal composition (insecticide; see col. 14, lines 40-46) in particulate form (nanoparticle) comprising a pesticide or behaviour modifying chemical impregnated thereon or associated therewith (biologically active materials or drugs incorporated into the polymer at the time of nanoparticle formation) and the particles include a magnetic material (magnetic particles).

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In regard to claim 20, Gref et al. discloses the behavior modifying chemical being a pheromone (see col. 14, lines 41-46).

In regard to claim 30, Gref et al. discloses non-pharmaceutical uses for the particles which include selective delivery of pesticides, insecticides, and pheromones which inherently means coating a surface where insects will come into contact with the biocide or pheromone (basic trap structure not being recited).

In regard to claim 50, Gref et al. discloses a plurality of particles (capsules) of a magnetic material (core material) having only on an external coating comprising a pesticide or behaviour modifying chemical (biocide).

10. Claims 1, 3-5, 7, 15, 16, 22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yaffe et al. 3,274,052.

In regard to claim 1, Yaffe et al. discloses a method of killing pests wherein an insect to be killed is exposed to a particulate composition (granular) including a magnetic material (iron) such that the insect slips (insects walking on granules would slip onto the area where particles are spread) onto a trap (an area where the particular composition is spread; trap structure not particularly recited) proximate the composition.

In regard to claim 15, Yaffe et al. discloses a pesticidal composition in particulate form (granular) which comprises composite particles (granules) each comprising a core of inert substrate (inert surface active agent on granular core materials which include iron; see col. 3, lines 68-end & col. 4, lines 1-25) having a pesticide (toxicant may be pesticide; see col. 3, lines 23-26) or behaviour modifying chemical impregnated thereon or associated therewith and the core being impregnated with a magnetic material (iron).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 21, 21/16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marston 3,056,724.

Marston discloses a magnetic material comprise cobalt oxide and iron powder, but does not disclose the magnetic material comprising strontium ferrite. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize strontium ferrite, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, and because strontium ferrite is an alloy exhibiting magnetic properties and would be employed by a person of ordinary skill in the art depending upon the ultimately desired composition. *In re Leshin*, 125 USPQ 416.

13. Claims 21, 21/16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gref et al. 5,565,215.

Gref et al. does not disclose the magnetic material comprising strontium ferrite. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize strontium ferrite, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, and because strontium ferrite is an



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alloy exhibiting magnetic properties and would be employed by a person of ordinary skill in the art depending upon the ultimately desired composition. *In re Leshin*, 125 USPQ 416.

14. Claims 21, 21/16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gref et al. 5,565,215 in view of Klaveness et al. 5,693,321.

Gref et al. discloses magnetic materials for being acted upon by a magnetic field and for diagnostic imaging, but does not particularly disclose the magnetic material being a ferromagnetic oxide. Klaveness et al. discloses that polymer particles that may contain paramagnetic, superparamagnetic or ferromagnetic substances which are of use in magnetic resonance imaging diagnostics. It would have been obvious to a person of ordinary skill in the art to modify the composition of Gref et al. such that it has the magnetic material comprising a ferromagnetic material such as strontium ferrite in view of Klaveness et al. since it is a known material used in diagnostic imaging and suitable and safe for use in medical applications.

15. Claims 2, 3, 6, 21, 21/16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yaffe et al. 3,274,052.

In regard to claim 2, Yaffe et al. discloses the core materials having a particle size range of about 4 (4.76mm/4760micron) to 80 (.177mm/177 micron) mesh, but does not disclose the particles with an average particle size diameter in the range of from 2 to 100 micrometers. It would have been an obvious matter of design choice to make the particle size diameter in the range of about 2 to 100 micrometers, since applicant has not disclosed that by doing so produces any unexpected results or is critical to the

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design and because a person of ordinary skill in the art would readily design the particles such that their diameter is appropriate for the size of the pests or insects to be destroyed.

In regard to claims 3, 6, and 21, Yaffe et al. does not disclose the magnetic material comprising a ferromagnetic oxide or strontium ferrite. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a ferromagnetic oxide and strontium ferrite, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, and because a ferromagnetic oxide and strontium ferrite are alloys exhibiting magnetic properties and would be employed by a person of ordinary skill in the art depending upon the ultimately desired composition. *In re Leshin*, 125 USPQ 416.

### ***Response to Arguments***

16. Applicant's arguments with respect to claims 1-28 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darren W. Ark whose telephone number is (571) 272-6885. The examiner can normally be reached on M-Th, 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on (571) 272-6891. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Darren W. Ark  
Primary Examiner  
Art Unit 3643

DWA